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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,399	07/20/2001	Michael W. LaCourt	961_006	9658
20874	7590	10/19/2004	EXAMINER	
WALL MARJAMA & BILINSKI 101 SOUTH SALINA STREET SUITE 400 SYRACUSE, NY 13202			LUDLOW, JAN M	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/910,399

Applicant(s)

LACOURT ET AL.

Examiner

Jan M. Ludlow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) 15-40 and 61-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 41-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/25/2002 etc.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_

1. Applicant's election with traverse of Group I in the reply filed on July 23, 2004 is acknowledged. The traversal is on the ground(s) that the inventions are so related that there is no burden in searching multiple inventions. This is not found persuasive because the features of the inventions as claimed differ significantly and would require different search terms in electronic searching, leading to retrieval and analysis of different references, as well as analysis of different issues of patentability, significantly multiplying the burden on the examiner who is granted only a limited number of hours to examine each application.
2. The requirement is still deemed proper and is therefore made FINAL.
3. Claims 1-14, 41-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. In claim 1, it is unclear what structural limitation is intended by the method of use recitation of lines 6-7. In claim 6, "a said" is unclear. Claim 41 is unclear as to scope in that the intended use of lines 5-6 relate to elements of the preamble, which elements are not positively recited elements of the invention. Claims 44, 51 are unclear because it is unclear whether "said primary sample supply" is intended to be positively recited. Claim 52 is unclear because it is unclear whether "said dry and wet chemistry system" is intended to be positively recited. In claim 58, line 1, "or" should be "for".

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

6. A person shall be entitled to a patent unless –

7. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

10. Determining the scope and contents of the prior art.  
11. Ascertaining the differences between the prior art and the claims at issue.  
12. Resolving the level of ordinary skill in the pertinent art.  
13. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a

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later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 1-3, 6-7, 41-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Samsoundar (WO 99/47261).

16. Samsoundar (WO 99/47261) teaches a blood analyzer apparatus having a sample handling means, e.g., 94 carrying sealable tips 1,2, in stations 90, sealing means 5, spectrophotometer 14 and smaller tips 4 for insertion into the sealable tips. Note with respect to claim 41, "said buffer acting..." is a statement of intended use and not given patentable weight. Note that the chemistry systems are not claimed. The recitation "A buffer for interconnecting..." has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

17. Claims 1-2, 8, 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Corbett (WO 92/20776).

18. Corbett teaches ring 14 with stations 12 for supporting heat-sealed pipet tips. Note with respect to claim 41, "said buffer acting..." is a statement of intended use and not given patentable weight. Note that the chemistry systems

are not claimed. The recitation "A buffer for interconnecting..." has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

19. Claims 4, 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Samsoundar as applied to claims 1, 41 above, and further in view of Corbett.

20. Samsoundar fails to teach heat sealing.

21. Corbett teaches a method for sealing pipette tips for use as containers by heat sealing as described above.

22. It would have been obvious to use a heat sealer in the device of Samsoundar in order to use an art recognized method of sealing tips for use as containers as taught by Corbett.

23. Claims 3-4, 42, 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corbett as applied to claims 1-2, 41 above.

24. Corbett fails to explicitly teach apparatus for heat sealing.

25. It would have been obvious to provide a device to perform the heat sealing step of Corbett in order to perform the method as described.

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26. Claims 1-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobs *et al* (USP 5,846,492) in view of Corbett and/or Samssoondar.

27. Jacobs *et al* teach a sample-metering device in a clinical analyzer with a sample handling apparatus 20 having a plurality of sample containers 19 containing sample; a sample metering apparatus having a proboscis 46, metering tip 48 supply in ring 20, a metering pump 71; a sample processing apparatus 30 having one or more test elements E. An air tube 100 may be applied to the bottom of the tip to prevent leakage (col. 5, lines 15-25). The primary analyzer cycle method comprising: attaching a tip to the proboscis to create the metering assembly; moving the metering assembly to immerse the tip in the sample and aspirate sample from the sample container; moving the metering assembly to a dispense the sample liquid on to the test element; the test element is linearly transferred to an incubator (not shown) within which it is read or detected at a test station 146 (column 8, lines 10-18). Then, Jacobs *et al* teach performing a secondary quality cycle comprising measurements of the sample through-the-tip 48 at the NIR via spectrophotometer 110 at station 82 (column 5, lines 1-30). Note: the reference teaches the sample liquid can be deposited on the test slide before the though-the-tip analysis (column 8, lines 23-27).

28. Jacobs *et al* do not teach a sample handler for holding sealed tips.

a. The teachings of Samssoondar and Corbett are given above.

b. It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have included in the apparatus of Jacobs

*et al*, a holder and sealer for the pipette tip of Corbett *et al* in order to allow for efficient transfer of the sample and provide time savings and avoidance of sample contamination (page 3, lines 14-20) or a holder and sealer for the pipette tip of Samsoondar in order to provide known sealing means and conveyance as taught by Samsoondar and/or Corbett in place of air pressure 100 to maintain liquid in a pipet tip for reaction and/or measurement in the tip.

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan M. Ludlow whose telephone number is (571) 272-1260. The examiner can normally be reached on Monday-Thursday, 11:30 am - 8:00 pm.

31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jan M. Ludlow  
Primary Examiner  
Art Unit 1743

Jml  
October 18, 2004